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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,584	01/24/2002	Gerhard Pfeifer	5005.1018	4703
23280	7590	04/20/2004	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			PRITCHETT, JOSHUA L	
			ART UNIT	PAPER NUMBER
			2872	
DATE MAILED: 04/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/056,584	Applicant(s) PFEIFER, GERHARD	
	Examiner Joshua L Pritchett	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to Request for Continued Examination filed February 9, 2004 and Amendment filed December 11, 2003. Claims 1, 6 and 7 have been amended and claim 8 has been added as requested by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Georges in view of Admitted Prior Art.

Regarding claim 1, Georges teaches a baseplate (35), retainable on the microscopic stage (Fig. 1), in which is configured, for reception of the specimen slide (Fig. 6), an opening (45) with a rim (Fig. 6). The opening of Georges is further discussed in col. 6 lines 1-4. Georges further teaches flat support surfaces (21 and 21') and at least one abutment surface (27), extending substantially perpendicular to the support surface (Fig. 6), for the specimen slide are form at the rim (Fig. 6). The flat support surfaces (the top surface on which the slide rests of 21 and 21' as

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seen in Fig. 6) and the at least one abutment surface (the vertical face of 27 adjacent the slide) extend perpendicular to one another. Georges further teaches at least one spring element (48) with which the specimen slide arranged in the opening (45) of the baseplate (35) is pressed against the at least one abutment (27) surface of the opening. Georges teaches the use of an undercut abutment surface (27) to help maintain the position of the slide (col. 5 lines 24-26). Georges lacks reference to the slide extending above the upper edge of the abutment surface. Admitted Prior Art teaches that it is known in the art to have the slide extend above the upper edge of the abutment surface (Fig. 3 current application). It would further have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Georges slide extend above the upper edge of the abutment surface as taught by the Admitted Prior Art for the purpose of allowing the viewing apparatus of the microscope to get as close as possible to the specimen slide without interference from the abutment surface.

Regarding claim 2, Georges teaches the at least one abutment surface of the opening is configured in such a way that the side of the specimen slide resting against it makes contact only in a region spaced away from the support surface and arranged above the horizontal center line of the specimen slide (col. 5 lines 24-26). By the slide engaging an undercut abutment surface the slide must inherently contact the abutment surface in a region spaced away from the support surfaces.

Regarding claim 3, Georges teaches an undercut, which cuts away the contact region with the specimen slide, is configured in the abutment surface in the transition region from the support surface to the abutment surface (col. 5 lines 24-26).

Regarding claims 4 and 5, Georges teaches the invention as claimed, but lacks specific reference how the undercut of the abutment surfaces (27) is made. Official Notice teaches that it is well known in the art to use either a conical milling cutter or a drilling method to create the undercut in a plastic or metal material (which are common materials used in microscopes). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use either drilling or a conical milling cutter to create the undercut in the abutment surface of Georges for the purpose of creating an undercut with precise dimensions with ordinary equipment in order to reduce production costs.

Regarding claims 6 and 8, Georges teaches an X-Y microscope stage defining a stage surface (Fig. 6). Georges further teaches a holder, arranged above the stage surface of the X-Y microscope stage and being positionable in X and Y directions (col. 12 lines 33-34), for positioning the specimen slide. Georges further teaches an opening for the specimen slide is formed in a baseplate (35) of the holder, wherein the opening is configured with support surfaces (21 and 21') and abutment surfaces (27) for the specimen slide. Georges further teaches a spring element (48) is mounted on the specimen slide for pressing the specimen slide against the abutment surface of the opening so that the specimen on the specimen slide is located opposite the stage surface (Fig. 6). Georges teaches the use of an undercut abutment surface (27) to help maintain the position of the slide (col. 5 lines 24-26). Georges lacks specific reference to a specimen collection device, however Georges teaches that such a device is known and used in the art. Georges further teaches a collection device having at least one container for collecting a specimen that has be cut out, wherein the collection device being conveyable to an opening working space configured between the holder and the stage surface (col. 1 lines 17-21). Georges

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further lacks reference to the slide extending above the upper edge of the abutment surface.

Admitted Prior Art teaches that it is known in the art to have the slide extend above the upper edge of the abutment surface (Fig. 3 current application). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Georges invention include a specimen collection device for the purpose of preserving the specimen for further analysis at a later date. It would further have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Georges slide extend above the upper edge of the abutment surface as taught by the Admitted Prior Art for the purpose of allowing the viewing apparatus of the microscope to get as close as possible to the specimen slide without interference from the abutment surface.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Georges in view of Hellmuth and Admitted Prior Art.

Georges teaches the invention as claimed and discussed in the rejection of claim 6, but lacks reference to the use of an apparatus for laser cutting the specimen. Hellmuth teaches the use of an apparatus for laser cutting the specimen in a microscope (col. 11 lines 67 – col. 12 line 2). Georges further lacks reference to the slide extending above the upper edge of the abutment surface. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the Georges invention include the laser cutting apparatus as taught by Hellmuth for the purpose of removing pieces of the specimen to examine a cross section of the specimen or reduce the size of the specimen.

Response to Arguments

Applicant's arguments filed December 11, 2003 have been fully considered but they are not persuasive.

On pages 6 and 7 of Amendment, applicant argues that the Georges references lacks the abutment surface contacting the slide below the upper edge of the slide and higher than the point of contact of the spring. The examiner acknowledges that Georges does not teach this limitation. However, the Admitted Prior Art as discussed in the rejection above teaches this limitation.

On pages 6 and 7 of Amendment, applicant argues that the Admitted Prior Art lacks reference to the abutment surface being undercut. The examiner acknowledges that the Admitted Prior Art does not teach this limitation. However, Georges as discussed in the rejection above teaches this claimed limitation.

Applicant's arguments, see Amendment, filed December 11, 2003, with respect to the rejection(s) of claim(s) 1-5 under 35 U.S.C. 101 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 U.S.C. 103.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L Pritchett whose telephone number is 571-272-2318.

The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLP 


DREW A. DUNN
SUPERVISORY PATENT EXAMINER